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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,227	01/23/2004	Peng Zhang	06491 USA	9139

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EXAMINER	
KUGEL, TIMOTHY J	
ART UNIT	PAPER NUMBER
1712	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,227	ZHANG ET AL.	
	Examiner	Art Unit	
	Timothy J. Kugel	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26 and 29-46* is/are pending in the application.

4a) Of the above claim(s) *29-36 and 39-46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26,37 and 38* is/are rejected.

7)☒ Claim(s) *38* is/are objected to.

8)☒ Claim(s) *26 and 29-46* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/18/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 26 and 29-46 are pending as amended on 18 October 2006, claims 1-25, 27 and 28 being cancelled. Claims 29-36 and 39-46 are withdrawn from consideration.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Applicant's election with traverse of the species of an alkyl alcohol or a polymeric alcohol having one or more hydroxyl groups in the reply filed on 18 October 2006 is acknowledged. The traversal is on the ground that there was no serious burden in searching all of the additives. This is not found persuasive because more than 30 genera are claimed which would impose a serious burden to search.

The requirement is still deemed proper and is therefore made **FINAL**.

4. Newly submitted claims 29-36 and 39-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claim 26—and its dependent new claims 37 and 38—and the invention of new claims 29-36 and 39-46 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product. See MPEP § 806.05(h). In the instant case the product could be used in a materially different process such as being as a solvent in a non-lithographic application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-36 and 39-46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

5. The information disclosure statement(s) submitted on 18 October 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Response to Amendment

6. Applicant is thanked for amending the specification to correct minor informalities.

7. Applicant's cancellation of claims 1-25, 27 and 28, filed 18 October 2006, renders the previously cited rejection of those claims under 35 USC § 102, 103 and/or 112 moot.

8. Applicant's amendment, filed 18 October 2006, with respect to requiring the carrier fluid to be selected from the group consisting of bicyclohexyl, glycerol and cis-2-methylcyclohexanol has been fully considered and overcomes the prior art.

The provisional rejection of claim 26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 13 and 17-32 of copending Application No. 10/804,513 has been withdrawn.

The rejection of claim 26 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rolland has been withdrawn.

The rejection of claim 26 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McDermott has been withdrawn.

Response to Arguments

9. Applicant's arguments with respect to claims 26 and 29-46 have been considered but are moot in view of the new grounds of rejection.

Claim Objections

10. Claim 38 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim 38 recites "The composition of claim 26 wherein the at least one carrier medium is an aqueous fluid"; however, the carrier fluid of claim 26 is limited to being

selected from the group consisting of bicyclohexyl, glycerol and cis-2-methylcyclohexanol.

Double Patenting

11. Claims 26, 37 and 38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28-30 of copending Application No. 11/030,132.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a composition comprising a carrier fluid that can comprise an aqueous fluid or a non-aqueous fluid selected from the group consisting of bicyclohexyl, glycerol and cis-2-methylcyclohexanol and an additive comprising the same Markush-type group as instantly claimed, which fully embraces the instantly claimed composition. Since the copending application claims the same composition as claimed, the light transmission, refractive index and solubility of the components of the copending composition would inherently be the same as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102 and/or 35 USC § 103

12. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,275,243 (Saitoh hereinafter).

Saitoh teaches a composition that is a mixture of bicyclohexyl and any of—or a mixture of—a number of polyhydric alcohols (Column 3 Line 59 – Column 4 Line 13).

Since Saitoh teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the light transmission, refractive index and solubility of the components of the Saitoh composition would inherently be the same as claimed.

Regarding claim 26, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

13. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,966,977 (Takaki hereinafter).

Takaki teaches a composition that is a mixture of bicyclohexyl and alcohols such as tetrahydrofuran and/or ethylene glycol (Column 4 Lines 8-31).

Since Takaki teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the light transmission, refractive index and solubility of the components of the Takaki composition would inherently be the same as claimed.

Regarding claim 26, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 4,770,802 (Ishida hereinafter) teaches compositions similar to Saito and Takaki comprising bicyclohexyl and alcohols.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
Art Unit 1712

RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700